

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 3653**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Koji SUGIYAMA et al.

Group Art Unit: 3653

Application No.: 10/509,382

Examiner: G. MCCLAIN

Filed: May 31, 2005

Docket No.: 121284

For: SHEET PACKAGE

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1-17 are pending in this application. In reply to the October 12, 2007 Office Action, reconsideration of the rejections is respectfully requested, at least in light of the following remarks.

Claims 1-12, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication 48-104334 (JP 48) in view of U.S. Patent Application Publication No. 2003/0164317 (Fujiwara); claims 1-11, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,883,852 (Medoff) in view of Fujiwara; claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,217,019 (Ishiduka) in view of Fujiwara; claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Medoff in view of Fujiwara; and claim 14 is rejected under 35

U.S.C. §103(a) as being unpatentable over JP 48 in view of Fujiwara and in further view of Medoff. These rejections are respectfully traversed.

All of the rejections in the outstanding Office Action rely on Fujiwara, which is not prior art to the above-identified application. Specifically, Fujiwara is not prior art under 35 U.S.C. §102(e) because it is a national stage application of PCT/JP01/04368 which was not published in the English language under Article 21(2). As stated in 35 U.S.C. §102(e), "an international application filed under the treaty defined in §351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language." The PCT application corresponding to Fujiwara was published in the Japanese language, and accordingly is not prior art under 35 U.S.C. §102(e) as of the international filing date.

Fujiwara has an effective prior art date of September 4, 2003 (its publication date). See MPEP §2136.03(II)(B) which states that if the international application was not published in English, "the reference may be applied under 35 U.S.C. §102(a) or (b) as of its publication date, or 35 U.S.C. §102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable)." The above-identified application has an effective filing date of March 17, 2003, which is the international filing date corresponding to this application. See 35 U.S.C. §363. Accordingly, Fujiwara is not prior art with respect to the above-identified application. Thus, for this reason the rejections over Fujiwara should be withdrawn.

Accordingly, withdrawal of the rejections of record is respectfully requested.

Furthermore, the rejections of claims 1-12, 14, 16 and 17 over JP 48 and Fujiwara are improper because the combination of JP 48 and Fujiwara does not disclose a recloseable flap with a fastening member to fasten the flap in a closed state. The Office Action cites

paragraph [0064] of Fujiwara as allegedly disclosing a fastening member in the form of tape. Paragraph [0064] of Fujiwara states, *inter alia*, "Alternatively, the cap-shaped cover part 2 may be attached using thin tape such as cellophane tape, with the cap-shaped cover part 2 being separated by pulling off such tape." Fujiwara does not describe the use of cellophane tape in detail, and does not indicate whether such cellophane tape is part of the package itself, as required in claim 1. Moreover, there is no suggestion that the use of the cellophane tape would provide a "recloseable flap" as required in claim 1, or whether it only works to initially secure the cap part 2. For example, there is no disclosure in Fujiwara that the cap-shaped cover part is reclosed once it is removed.

Additionally there is no motivation to use the cellophane tape in Fujiwara with the package in JP 48. The package in JP 48 includes a cut-away portion 5, so that even if flap 3 were folded back over part of the sheets (for example, as shown in the dashed lines in Fig. 3), it leaves a substantial area of the sheets exposed on the face and the sides of the sheets. Accordingly, a person of ordinary skill in the art would not use the cellophane tape of Fujiwara to secure the flap 3 in its "closed" state, because the tape would contact the sheets and would accordingly not protect the sheets as alleged in the Office Action. Thus, claim 1 is patentable over JP 48 and Fujiwara for at least these reasons.

Independent claim 10 also recites that the package includes a fastening member, and is therefore also patentable over JP 48 and Fujiwara.

Claims 2-9, 11, 12, 14, 16 and 17 depend from one of independent claims 1 and 10 and are therefore also patentable over JP 48 and Fujiwara for at least the reasons enumerated above, as well as for the additional features they recite.

For example, regarding the rejections of claims 16 and 17, Applicants note that the Examiner's reliance on MPEP §2115 is improper. Claim 16, for example, depends from claim 1 and recites that the sheets include heat-sensitive sheets. Claim 17 depends from

claim 10 and is otherwise identical to claim 16. Applicants note that independent claims 1 and 10 recite a sheet package having sheets. Claims 16 and 17 recite that these sheets have a characteristic of being heat-sensitive. Accordingly, these features must be considered in determining the patentability of claims 16 and 17. MPEP §2115 relates to expressions of intended operation, and is not relevant to claims 16 and 17. Accordingly, for this additional reason, withdrawal of the rejections of claims 16 and 17 is respectfully requested.

Accordingly, withdrawal of the rejections over the combination of JP 48 and Fujiwara is respectfully requested.

The rejections of claims 1-11, 13, 14, 16 and 17 over Medoff and Fujiwara should likewise be withdrawn because Medoff does not disclose "sheets as print mediums for a printer" and the package in Medoff is not "configured for use in a printer," as recited in claim 1. Medoff relates to a tissue compact that includes facial tissue. A person of ordinary skill in the art would not consider facial tissue as print mediums, and would not consider a tissue compact as configured for use in a printer. Additionally, as discussed above Fujiwara does not indicate whether the cellophane tape is part of the package, or whether it would provide a recloseable flap, as recited in claim 1.

Furthermore, the Examiner's proposed motivation to modify Medoff in view of Fujiwara fails because a person of ordinary skill in the art would not modify a tissue compact based on the teachings of Fujiwara to protect the sheets prior to printing, because facial tissue is not used in printing and generally does not need to be carefully protected.

Independent claim 10 recites similar features referred to in connection with claim 1 above, and is therefore also patentable over the combination of Medoff and Fujiwara.

Claims 2-9, 11, 13, 14, 16 and 17 depend from one of independent claims 1 and 10 and are therefore also patentable over Medoff and Fujiwara for at least the reasons enumerated above, as well as for the additional features they recite.

For example, the Examiner also relies on MPEP §2115 to reject claims 16 and 17.

This rejection is improper for at least the reasons discussed above.

The rejection of claims 15 over Ishiduka and Fujiwara should also be withdrawn. Independent claim 15 also recites a sheet package with a "recloseable flap member" and a "fastening member to fasten the flap in a closed state where the flap covers a part of the sheets." The Office Action does not indicate that Ishiduka discloses a "recloseable flap member" and, as can be seen in Ishiduka at Figs. 3A-4C, there is no recloseable flap member. As discussed above, the application of Fujiwara fails because it does not indicate whether the cellophane tape is part of the package or whether it would provide a recloseable flap.

Furthermore, the Office Action does not explain how the alleged "fastening member" in Fujiwara would be combined with Ishiduka to meet the features in claim 1. Thus, claim 15 is also patentable over the combination of Ishiduka and Fujiwara.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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